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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,996	03/11/2004	Ryan L. Roach	20003.0078	4650

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EXAMINER

HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/796,996

Applicant(s)

ROACH ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-22 and 26-45 is/are rejected.
- 7) ☒ Claim(s) 15, 16 and 23-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 1, 2, 4-6, and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Antonious (EP 0285844 A2).

Regarding claim 1, Antonious discloses a golf club head, comprising: a body defining a striking face 18, a top line 26, a sole, and a back, and having a heel 12 and a toe 14; and wherein the back contains a cavity therein; and the cavity contains a plurality of recesses therein and the recesses extending away from the cavity (See Figures 1-5).

Regarding claim 2, Antonious discloses the recesses being aligned substantially longitudinally to the striking face in a heel-to-toe direction, and the plurality of recesses including a first recess positioned in a heel portion of the cavity and a second recess positioned in a toe portion of the cavity (See Figures 1-5).

Regarding claims 4 and 5, Antonious discloses the depth of the recess being ½ inch (See Column 5, lines 20 through 36).

Regarding claim 6, Antonious discloses a first weight positioned in a first recess and a second weight positioned in a second recess (See Column 6, lines 17 through 49).

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Regarding claim 45, Antonious discloses the club head being an iron-type (See Figure 1).

2. Claims 1, 2, 6, 8-11, 13, 19, 21, 22, 26, 27, 28, 32, 37, and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeda (USPN 6290609).

Regarding claim 1, Takeda discloses a golf club head comprising a body defining a striking face 4, a top line 8, a sole 9, and a back 10, and having a heel 6 and a toe 7; and wherein the back contains a cavity 10A therein; and the cavity contains a plurality of recesses 12 therein and the recesses extending away from the cavity (See Figures 1-14).

Regarding claim 2, Takeda discloses the recesses being aligned substantially longitudinally to the striking face in a heel-to-toe direction, and the plurality of recesses including a first recess positioned in a heel portion of the cavity and a second recess positioned in a toe portion of the cavity (See Figure 1).

Regarding claim 6, Takeda inherently discloses a first weight positioned in a first recess and a second weight positioned in a second recess (See Figures 1-14).

Regarding claims 8 and 21, Takeda inherently discloses the first weight member 11A having a specific gravity greater than the specific gravity of the club head, the second weight member 11D has a specific gravity greater than the club head specific gravity, and the third weight member 11B having a specific gravity less than the club head specific gravity (See Column 3, lines 13 through 42).

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Regarding claim 9, Takeda discloses the first weight member and the second weight member specific gravity being substantially the same (See Column 3, lines 13 through 42).

Regarding claim 10, Takeda discloses the first weight member 11A having a first specific gravity, the second weight member 11B having a second specific gravity and the first specific gravity is greater than the second specific gravity.

Regarding claim 11, Takeda discloses the first weight member 11C having a first specific gravity, the second weight member 11D having a second specific gravity and the first specific gravity is less than the second specific gravity.

Regarding claim 13, Takeda discloses the plurality of recesses further including a third recess intermediate the first and second recess (See Figures 1-14).

Regarding claim 19, Takeda discloses a first weight positioned in a first recess and a second weight positioned in a second recess and a third weight member positioned within the third recess (See Figures 1-14).

Regarding claim 22, Takeda disclose the first weight 11A or 11C, second weight 11C or 11D, and third weight 11B having a first, second, and third specific gravity (See Column 3, lines 13 through 42).

Regarding claim 26, Takeda discloses the first specific gravity greater than the second specific gravity 11C.

Regarding claim 27, Takeda discloses the first specific gravity being less than the second specific gravity.

Regarding claim 28, Takeda discloses the first and second specific gravity are each greater than the third specific gravity (See Column 3, lines 13 through 42).

Regarding claim 32, Takeda discloses the recesses aligned substantially transverse to the striking face in a front-to-back direction and extending in a heel-to-toe direction, and the plurality of recesses include a first recess positioned adjacent the back (See Figure 6).

Regarding claim 37, Takeda discloses a plurality of recesses including a second recess adjacent the first recess (See Figure 6).

Regarding claim 45, Takeda discloses the club head being an iron-type (See Figure 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antonious (EP 0285844 A2).

Regarding claim 3, Antonious discloses that the size of the recesses may be varied based upon the type of weighting desired by the user (See Column 6, lines 17 through 49). One having ordinary skill in the art would have found it obvious to have the recesses at any volume and depth in order control the weight of the club head.

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Regarding claims 8-11, Antonious does not disclose specific gravity relationship of the weights to each other. Applicant notes that the specific gravities of the weights are used for attaining different types of swings. Antonious also discloses that the weights may be used to for attaining different types of swings (See Column 6, lines 17 through 49). One having ordinary skill in the art would have found it obvious to have weight with any type of specific gravity relation to the each other and the club head, as taught by Antonious, in order to attain different types of swings.

Regarding claim 7, Applicant does not disclose why it is critical for the weights to have a mass greater than or equal to 10 grams in order to attain the invention, therefore, one having ordinary skill in the art would have sought such to be an obvious matter of design choice. The weights of Antonious would perform equally as well because it allows for better control of the club head.

4. Claims 3-5, 7, 14, 17, 18, 20, 33, 34, 41, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda (USPN 6290609).

Regarding claim 3-5, 17, and 18, 33, Takeda shows the recesses having a volume and depth but does not explicitly disclose the volume and depth. Applicant does not disclose why it is critical to have the volume and depth of a particular dimension in order to attain the invention, therefore, one having ordinary skill in the art would have sought such to be and obvious matter of design choice. One would expect Takeda to perform equally as well because the size is sufficient for the weights to fit within.

Regarding claims 7, 14, and 20, Takeda does not disclose the mass of the weight member. Applicant does not disclose why it is critical to have the mass of the

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weight members equal to or greater than 10 grams in order to attain the invention, therefore, one having ordinary skill in the art would have sought such to be an obvious matter of design choice. One would expect Takeda to perform equally as well because it enables weight and inertia adjustment of the club head to that desired by the user.

Regarding claim 34, Takeda discloses a plurality of recesses including a second recess adjacent the first recess wherein a weight member is positioned within the second recess (See Figure 6).

Regarding claim 41, Takeda does not disclose a plurality of recesses having a first recess transverse the striking face and a second and third recess longitudinal to the striking face. Takeda show an embodiment of recesses in the longitudinal direction and an embodiment of recess extending in the transverse direction (See Figures 1 and 6). Both embodiments serve the same purpose; therefore, one having ordinary skill in the art, in view of both embodiments, would have found it obvious to have a first recess transverse the striking face and a second and third recess longitudinal to the striking face in order to adjust the moment of inertia, and weight of the club head.

Regarding claim 43, Takeda discloses a fourth recess intermediate the second and third recesses (See Figure 1).

5. Claims 12, 29-31, 35, 36, 38-40, 42, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda (USPN 6290609) in view of Carmeron (USPN 5944619).

Regarding claim 12, 29, 36, 38, 40, 42, and 44, Takeda does not disclose having a dampening insert. Cameron discloses a club head having a dampening insert 34

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within a recess (See Abstract). One having ordinary skill in the art would have found it obvious to incorporate a dampening insert within any recess of Takeda, as taught by Cameron, in order to improve the overall feel of the golf club.

Regarding claims 30 and 39, Takeda does not disclose the mass of the weight member. Applicant does not disclose why it is critical to have the mass of the weight members equal to or greater than 10 grams in order to attain the invention, therefore, one having ordinary skill in the art would have sought such to be an obvious matter of design choice. One would expect Takeda to perform equally as well because it enables weight and inertia adjustment of the club head to that desired by the user. Cameron inherently discloses the insert being less than 10 grams.

Regarding claims 31 and 35, Takeda inherently discloses the first weight member having a specific gravity greater than the specific gravity of the club head, the second weight member has a specific gravity greater than the club head specific gravity, and the third weight member having a specific gravity less than the club head specific gravity (See Column 3, lines 13 through 42). Cameron inherently discloses the specific gravity of the dampening insert being less than that of the club head (See Column 3, lines 1 through 37).

Allowable Subject Matter

Claims 15, 16, and 23-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 10/13/2004 have been fully considered but they are not persuasive. Applicant argues that Antonious and Takeda does not disclose recesses within the cavity. The examiner disagrees. Applicant claims a recess extending away from the cavity. Also, Applicant never defines the recess as being an indentation within the cavity; therefore, rejections were made to cover both in the broadest reasonable interpretations. Furthermore, extending away from the cavity would imply that the recess is extending away from the back of the clubhead. Figure 4, in particular, of Antonious shows a cavity containing recesses (see elements 32 and 30) extending away from the cavity, i.e. in a direction away from the back. In alternative Takeda discloses a club head having a cavity where in the cavity contains openings, or recesses, for fitting weights therein. Clarity to the claims are clearly needed by the applicant. Until such is made, the above action has been furnished.

In response to the 103 rejections, see the above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH

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